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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------------------------------|-------------|----------------------|--------------------------|------------------|
| 10/668,312 | 09/24/2003 | Takashi Nakahara | 056208.52792US | 4684 |
| 23911 | 7590 | 11/22/2005 | EXAMINER | |
| CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300 | | | LOUIS JACQUES, JACQUES H | |
| | | ART UNIT | PAPER NUMBER | 3661 |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/668,312 | NAKAHARA ET AL. | |
| | Examiner | Art Unit | |
| | Jacques H. Louis-Jacques | 3661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-19 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 14 fails to further limit the subject matter of a previous claim because a claim cannot depend on itself. Claim 14 depends on claim 14.

For purpose of examination, the examiner considers claim 14 to depend on claim 13. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 13 and 16, the recitation "transmission means for receiving" is ambiguous and renders the claim indefinite. Applicant is suggested to change "transmission means" to "communications means".

Claims 14-5 and 17 are also rejected based on their dependency.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Carroll et al [6,859,699].

Carroll et al discloses a network-based method and system for collecting and distributing data (information). According to Carroll et al, there is provided an operation input equipment (device) of an information terminal unit mounted on a vehicle or a user for inputting information specification of the vehicle information to be transmitted to the information center (data provider) [columns 1 and 2]. Carroll et al discloses communications (receiving) means for receiving from said information center a vehicle information according to said service to be provided (abstract, column 1, line 62 to column 2, line 9). Carroll et al also discloses that the unit mounted on the vehicle receives from the information center (data provider) the vehicle information specification preset from an external information terminal, and the received vehicle information specification is displayed on the display equipment of the unit mounted on the vehicle (figures 3a-3d, column 5). Furthermore, Carroll et al discloses operation input means (i.e., user interface 214) for inputting a selected specification of the vehicle information to be transmitted to said information center, based on said received vehicle information specification (figures

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2, 4-5; column 1, line 62 to column 2, line 27 and column 6, line 57 to column 7, line 15).

In addition, Carroll et al discloses means for storing the selected specification of the vehicle information inputted and for storing the vehicle information relating to conditions of the vehicle, based on said selected specification of the vehicle (column 4, lines 48-66; column 5; lines 1-15). See also column 2 and 3. Additionally, Carroll et al discloses transmitting the stored information to said information center (figures 4 and 5). As described in column 5, Carroll et al discloses setting a time period during which the vehicle information collected by the unit mounted on the vehicle is transmitted based on either an operation of direction means provided with the vehicle mounted unit or by the vehicle having reached a point which meets a predetermined condition [such as when automotive service is carried out or within a licensing period]. Carroll et al discloses that when the selected specification of the vehicle information has been selected, charges or discount rates thereof are displayed at the vehicle mounted unit and the charges or the discount rates thereof are adjusted according to setting operation of the selected specification. See figure 4 [404, 415], figures 3a-3d and columns 6-8.

6. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizuishi [US 2003/0163248].

Mizuishi discloses an information management system or vehicle information collection system having a vehicle-mounted unit (10) for collecting vehicle information to be transmitted to an information center (20) for providing services based on the collected vehicle information. See page 1. According to Mizuishi, there is provided an

operation input equipment (device) of an information terminal unit mounted on a vehicle or a user for inputting information specification (e.g., identification) of the vehicle information to be transmitted to the information center (page 1, [0010]); means for storing the inputted vehicle information into the unit mounted on the vehicle [page 2, [0013]]; means for recording the vehicle information of the vehicle carrying the unit according to the stored vehicle information specification [page 2]; and means for transmitting the stored vehicle information to the information center (pages 1 and 2 [0013]). As further described page 3, the unit mounted on the vehicle receives from the information center (data provider) the vehicle information specification preset from an external information terminal, and the received vehicle information specification is displayed on the display equipment of the unit mounted on the vehicle. In addition, Mizuishi discloses that the information center (service provider), based on the information specification of the [predetermined] vehicle information, bills the user [calculates] service charges when providing a user with services. See page 2. Additionally, according to Mizuishi, when information specification has been selected, charges or discount rates thereof are displayed on the output equipment or information terminal of the unit mounted on the vehicle, and the charges or discount rates thereof are adjusted in conformity to the setting operation based on the information. See pages 1 and 2 [0015], [0017]. Mizuishi also discloses a display equipment (device) for displaying information specifications. See figure 8.

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7. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ukai et al [6,823,258].

Ukai et al discloses a method and apparatus for gathering (collecting) vehicle information. According to Ukai et al, there is provided an operation input equipment (device) of an information terminal unit (2) mounted on a vehicle (1) or a user for inputting information specification of the vehicle information to be transmitted to the information center (information management center, 6) (abstract, figure 5); means for storing the inputted vehicle information into the unit mounted on the vehicle [figures 5, 6]; means for recording the vehicle information of the vehicle carrying the unit according to the stored vehicle information specification [figure 5]; and means for transmitting the stored vehicle information to the information center (figure 5). See also column 6-8. As further described in column 5, the unit mounted on the vehicle receives from the information center the vehicle information specification preset from an external information terminal, and the received vehicle information specification is displayed on the display equipment of the unit mounted on the vehicle. See column 1. In addition, Ukai et al discloses that the information center, based on the information specification of the [predetermined] vehicle information, bills the user [calculates] service charges when providing a user with services. See abstract, figure 6, and columns 15-16. Additionally, when information specification has been selected, charges or discount rates thereof are displayed on the output equipment or information terminal of the unit mounted on the vehicle, and the charges or discount rates thereof are adjusted in conformity to the setting

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operation based on the information. See abstract. Ukai et al also discloses a display equipment (device) for displaying information specifications. See figure 2, column 8.

Response to Amendments & Arguments

8. The amendments along with the arguments filed therewith on September 26, 2005 have been entered and carefully considered the examiner.

The substitute specification is acknowledged.

New claims 13-19 are presented for examination.

Applicant stated that “the vehicle mounted unit specifies or selects a condition for collecting vehicle, including the user’s intent regarding transmission of items of information, as set forth in the vehicle information specification.” None of the pending claims recites “user’s intent regarding transmission of items of vehicle” nor any of the claims recites, “setting forth ‘user’s intent’ in the vehicle information specification”, as asserted by Applicant.

The claims, taken claim 1 as exemplary, recite, “vehicle information collected by a unit mounted on a vehicle is transmitted to an information center … based on the vehicle information.” Emphasis added. However, none of the claims recites, “the vehicle information that coincides with the specified or selected collecting condition is collected and transmitted to the information center.”

On page 9 of 11 of the response, Applicant asserted that “[t]here is no disclosure [in Carroll et al] that vehicle information collected by sensors based on the specification received from an information center are transmitted to the information center.”

As noted above, the claims recite, “vehicle information collected by a unit mounted on a vehicle is transmitted to an information center … based on the vehicle information.” While there is provided in the claims “receiving from said information center a vehicle information specification according to said service to be provided”, there is no recitation in any of the claims that “vehicle information collected by sensors based on the specification received from an information center are transmitted to the information center.” In other words, the collection of vehicle information [by sensors] is not performed based on the specification received from the information center. Such feature is not recited in any of the pending claims.

Regarding the applied prior art references, Applicant argued that “none of the cited reference discloses or teaches a system having the above-identified features.” The examiner contends that it does not matter that none of the applied references discloses the above-identified features because these features are not recited in the claims.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (as noted above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the Carroll et al patent, Applicant argued, “[t]here is no disclosure that vehicle information collected by sensors based on the specification received from an information center are transmitted to the information center.” The examiner respectfully disagrees.

First, such limitation is not recited in the claims.

Although such feature is not recited in the claims, Carroll et al nonetheless discloses that computerized automotive service systems generally include a sensor and a data processing system. The sensor may be used to operatively connect with a vehicle to collect signals representative of a diagnostic state or vehicle parameters. The data processing system receives and processes signals collected by the sensor and generates diagnostic results. According to Carroll et al, that data is sensed or collected, including information needed for performing a service process, based on specification for the information center via the data transmission network.

With respect to Mizuishi reference, Applicant argued, “the user cannot specify a collecting condition for the vehicle information and a condition of the transmission of the vehicle information.” The examiner respectfully disagrees.

The user controls the second probe information. As described in paragraph [0009], for example, Mizuishi discloses that a mobile terminal [user] can enjoy information (referred to as second probe information) managed by an information management device on the condition that the mobile terminal [user] provides information (referred to as first probe information) collected by the mobile terminal.

Mizuishi, in addition, discloses in paragraph [0003] that the on-vehicle device collects running information of the probe car equipped with the on-vehicle device. The running information includes the following: a running speed, a direction in which the probe car is running, and a following distance between the probe car and a vehicle ahead.

Regarding the Ukai et al patent, Applicant argued, “nothing in Ukai et al, however, teaches or suggests a system in which the user can specify a collection condition or

conditions of the vehicle information and a condition for transmission of the vehicle information." The examiner respectfully disagrees.

As described in column 2 [lines 57-61], Ukai et al discloses a collection condition or conditions of the vehicle information. As described in columns 4 and 5 with respect to the input means, Ukai et al discloses that the user specifies the collection condition or conditions of the vehicle information. In column 6, Ukai et al discloses a condition for transmitting the vehicle information as set by the user.

In light of the above, claims 13-19 are being rejected and this office action is made final.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| | | |
|----------------|------------------|-----------|
| 4,404,639 | McGuire et al | Sep. 1983 |
| US 20030111525 | Sweeney et al | Jun. 2003 |
| US 20050027608 | Wiesmuller et al | Feb. 2005 |

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is 571-272-6962. The examiner can normally be reached on M-Th 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj

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PRIMARY EXAMINER